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In re Application of : DECISION ON
Kennedy et al :
PCT No.: PCT/EP03/01700 :
Application No: 10/505,361 : PETITION UNDER
Int. Filing Date: 20 February 2003 :
Priority Date: 21 February 2002 :
Attorney's Docket No.: 2G02.1-084 US : 37 CFR 1.47(a)
For: BLOOD ANALYZER AND PRICKING
DEVICE FOR USE IN BLOOD ANALYSIS :
: :
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This is in response to the "PETITION TO ACCEPT SIGNATURE BY CO-INVENTOR ON BEHALF OF INVENTOR WHO REFUSES TO JOIN IN APPLICATION OR CANNOT BE REACHED (37 CFR 1.47(a))" filed on 04 April 2005. The petition fee of \$130.00 has been paid by check.

BACKGROUND

On 20 February 2003, applicants filed international application PCT/EP03/01700, which claimed priority to an earlier application filed 21 February 2002. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 28 August 2003.

On 19 August 2004, applicants filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration was submitted at such time.

On 03 January 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" and \$130.00 late oath or declaration surcharge. These items must be submitted within two months from the date of this Notice or by 32 months from the priority of date the application, in order to avoid abandonment of the national stage application.

On 04 April 2005, petitioner filed the present petition, a declaration in support of filing on behalf of nonsigning inventor Mitchell A. Solis accompanied, inter alia, an executed Declaration without the signatures of Mr. Solis.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) – (2), and (3) of 37 CFR 1.47(a) but not requirement (4).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), the averments of Mr. Bradley K. Groff are sufficient to support a finding that the nonsigning inventor, Mr. Solis, refuses to sign because a complete copy of the application, assignment, and declaration and power of attorney was mailed to Mr. Solis on December 22, 2004 requesting that he review the application and sign the assignment and declaration. Mr. Groff has not received a response by Mr. Solis as to this date. In addition, Mr. Groff has provided the necessary evidentiary documents to support his averments.

Regarding requirement 3, petitioner has not provided a statement of the last known address of the missing inventor.

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Regarding requirement (4), petitioner has provided a defective executed composite declaration. The composite declaration is defective because it comprises of 1 sheet of page 1, 1 sheet of page 2, 3 sheets of page 3, 1 sheet of page 4. A composite declaration under 37 CFR 1.497(a) and (b) requires that the declaration must be complete and identify each inventor in each set of declarations provided. In this case there appears to be only one set that is.

Copies of the same page is not part of a proper declaration since it is considered a composite declaration and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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